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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR        | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------------|---------------------|------------------|
| 09/341,817      | 09/07/1999  | TAIINA TUULIKKI PUUMALAINEN | 7510.192USWO        | 5631             |

7590

08/07/2003

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EXAMINER

NGUYEN, DUC MINH

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 08/07/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/341,817

Applicant(s)

PUUMALAINEN, TAINA TUULIKKI

Examiner

Duc Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-8, 10, 12, 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Bayless et al (5,754,636).

Consider claim 1. Bayless teaches a telecommunication terminal arrangement (computer telephone system 10, fig. 1) comprising means for searching dial numbers stored in the terminal to locate a desire dial number (see fig. 14-18, telephone directory); means for commanding a transmitter (the telephone inherently comprises of a transmitter and a receiver) of the terminal to

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begin making a call to a destination number (see fig. 34, 36-38, making and answer calls, dial button and/or icon); means for displaying the owner of each dial number which stored in a graphic memory (e.g., the name of the called party; see fig. 34, 36-38). Bayless further teaches while displaying the information identifying the owners of the dial numbers, a move occurs from one main category of the graphic memory to another main category; and within a desired main category, a move occurs between subcategories and/or members of the main category (fig. 6, 23, 52, 62 clearly show that the display can display multiple windows simultaneously).

Consider claim 2. Bayless' computer display clearly meets the limitations of this claim.

Consider claim 3. Fig. 6 clearly shows that the graphic information fills a significant part (50-100%) of the display.

Consider claims 4-5. Fig. 14-15 clearly suggest that the user can browse through the dial numbers (the telephone directory) using a computer mouse.

Consider claims 6-7. Fig. 6, 23, 52, 62 clearly suggest that a move occurs to the next image by touching or pressing an image (icons, virtual buttons) or by other means.

Consider claim 8. Bayless teaches a telecommunication terminal arrangement (computer telephone system 10, fig. 1) comprising means for searching dial numbers stored in the terminal to locate a desire dial number (see fig. 14-18, telephone directory); means for commanding a transmitter (the telephone inherently comprises of a transmitter and a receiver) of the terminal to begin making a call to a destination number (see fig. 34, 36-38, making and answer calls, dial button and/or icon); means for displaying the owner of each dial number which stored in a graphic

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memory (e.g., the name of the called party; see fig. 34, 36-38; telephone directory; col. 17, ln. 44 to col. 18, ln. 50). Bayless further teaches the graphic memory comprises a menu structure which comprises several main categories, and the main categories comprise one or more subcategories and/or members of the main category (fig. 6, 23, 52, 62 clearly show that the display can display multiple windows and menu simultaneously).

Consider claim 10. Bayless' computer display clearly meets the limitations of this claim.

Consider claim 12. Fig. 1, computer telephone system 10 clearly meets the limitations of this claim. Also see the rejection of claim 8.

Consider claim 14. The audio memory is met by the voice mail (col. 57, ln. 24-63).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9, 11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayless et al (5,754,636) in view of Iwata et al (6,009,338).

Consider claim 9. Bayless does not teach the main categories of the menu structure include one or more of the following main categories: health care services, authorities, relatives,

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friends, stores, financial institution. However, Bayless teaches that the main categories of the menu structure include one or more of the following main categories: telephone directory, make and answer calls, etc. It appears that the use of different menu would depend more upon the requirement of a specific application, than on any inventive concept.

Consider claim 11. Bayless does not teach that the terminal arrangement is realized in a single entirety.

Iwata teaches a mobile terminal which comprises address book, display means, searching means (col. 14, ln. 17-62), commanding means (dialing means; col. 24, ln. 10-29), earphone and microphone (3 and 5, respectively; fig. 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Iwata into the teachings of Bayless in order to provide a combination of a cellular phone and a telephone directory which is portable and mobility.

Consider claim 13. Bayless does not teach that the terminal arrangement is realized using a cellular phone.

Iwata teaches a mobile terminal which comprises address book, display means, searching means (col. 14, ln. 17-62), commanding means (dialing means; col. 24, ln. 10-29), earphone and microphone (3 and 5, respectively; fig. 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Iwata into the teachings of Bayless in order to

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provide a combination of a cellular phone and a telephone directory which is portable and mobility.

***Response to Arguments***

5. Applicant's arguments filed 6/15/03 have been fully considered but they are not persuasive.

Regarding the Bayless reference, applicant states that Bayless fails to teach graphic information identifying the owner of a dial number and a move from one main category of a graphic memory to another main category, and within a desired main category, a move between sub-categories and/or members of the main category. In contrast to applicant's assertions, graphic character is defined as printable symbol that includes digits and letters. Windows is defined as Graphics-based windows environment from Microsoft that integrates with and interacts with DOS. It provides a desktop environment similar to the Macintosh, in which applications are displayed in re-sizable, movable windows on screen. Bayless uses graphic-based windows that display graphic characters such as names, telephone numbers (fig. 15). It is noted that the names and telephone numbers in the telephone directories identify the owner of each dial number. Bayless further teaches moving from one main category of a graphic memory to another main category, and within a desired main category, a move between sub-categories and/or members of the main category (col. 19, ln. 1-10; fig. 6, 23, 52, 62 clearly show that the display can display multiple windows simultaneously).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., displaying the

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image of the person calling) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is further noted that inclusion of phrase “similar to” renders claim indefinite under 35 USC §112, 2nd paragraph, since the claim language fails to particularly point out and distinctly claims subject matter regard as the invention (Ex parte Pappas, 23 USPQ 2d 1636).

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Nguyen whose telephone number is (703) 308-7527.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Kuntz, can be reached on (703) 305-4708.

**Any response to this final action should be mailed to:**

**Box AF**

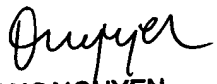
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 872-9315** (Group's Fax numbers)  
**(703) 746-7251** (Examiner's Fax number, only for proposed amendment)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

August 5, 2003

  
**DUC NGUYEN**  
**PRIMARY EXAMINER**